

REMARKS

Applicants acknowledge receipt of the Final Office Action dated October 21, 2003, in which the Examiner objected to the specification and rejected claims 34 and 37 as anticipated by *Gayer* (U.S. Patent 6,214,049).

Applicant has amended the claims to place them in condition for allowance and makes the following arguments. For the reasons set out below, Applicants traverse the rejections.

Objections to the Specification

The Examiner has indicated that the disclosure must be amended to "include the material incorporated by reference." Applicants respectfully submit that no such amendment is required.

As set out in MPEP 608.01:

Incorporation by Reference

An application for a patent when filed may incorporate "essential material" by reference to (1) a U.S. patent, (2) a U.S. patent application publication, or (3) a pending U.S. application, subject to the conditions set forth below. . .

If an application as filed incorporates essential material by reference to a U.S. patent or a pending and commonly owned U.S. application, applicant may be required prior to examination to furnish the Office with a copy of the referenced material together with an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the copy consists of the same material incorporated by reference in the referencing application. **However, if a copy of a printed U.S. patent is furnished, no affidavit or declaration is required. . .**

Nonessential subject matter may be incorporated by reference to (1) patents or applications published by the United States or foreign countries or regional patent offices, (2) prior filed, commonly owned U.S. applications, or (3) non-patent publications however, hyperlinks and/or other forms of browser executable code cannot be incorporated by reference. See MPEP § 608.01 . **Nonessential subject matter is subject matter referred to for purposes of indicating the background of the invention or illustrating the state of the art.** (emphasis added)

In the present specification, no essential subject matter is incorporated by reference. The instances of incorporation by reference are as follows:

- U.S. Patent Nos. 5,314,476, 5,073,373, 5,405,390, 5,236,456, 5,246,457, 4,440,750, 4,394,370, and 5,776,193 are mentioned in the Background and incorporated at the end of the specification. These references are mentioned as representative of the background of the invention and are therefore nonessential.
- U.S. Patent App. No. 09/023,612 is incorporated on page 7. This reference is mentioned as representative of the state of the art and its subject matter is nonessential.

- U.S. Patent No. 4,440,750 is incorporated on page 8. This reference is provided as an example of how to prepare atelopeptide collagen and tropocollagen, but those substances are known to those skilled in the art and therefore the subject matter of Patent No. 4,440,750 is nonessential. Nonetheless, a printout of the cited reference is submitted herewith, as allowed by MPEP 608.01(p).
- U.S. Patent Nos. 5,290,763 (Poser et al.), 5,371,191 (Poser et al.), or 5,563,124 (Damien et al.), and pending U.S. Patent Application No. 09/545,441, “particularly in Example 21,” are incorporated on page 10. These references describe an exemplary bone growth factor, but bone growth factors are known to those skilled in the art and therefore their subject matter is nonessential. Nonetheless, copies of the cited references are submitted herewith, as allowed by MPEP 608.01(p), along with an affidavit for the 09/545,441 application.

If the Examiner still feels that the application is incomplete, he is requested to identify with particularity the subject matter that needs to be included.

§ 102 Rejections

The Examiner has maintained the rejection of claim 34 over Gayer ‘049. Applicants have amended claim 34 to both place it in independent form, including the limitations of the claims from which it formerly depended, and also to include a requirement that the osteogenic implant material be “a paste that is capable of being molded to a desired shape.” This limitation is found in the specification in several places and is therefore not new matter. This limitation distinguishes the present invention from Gayer, which discloses a wool or fibers that are coated with various bioactive agents. The substance of Gayer is not a paste. The paste-like consistency of the claimed invention renders the present invention patentable over the art, as a paste-like osteogenic implant is neither anticipated by nor obvious in view of Gayer.

Claims 1-3 have been canceled, claims 4-22, 35 and 37 have been amended to depend directly or indirectly from allowable claim 34, and claims 23-33, 36, 38-54 and have been canceled. Thus all pending claims are now in condition for allowance.

Conclusion

For the reasons set out above, Applicants respectfully submit that the claims as amended are allowable over the art of record and that the case as amended is in condition for allowance. Applicants therefore request that the Examiner reconsider and withdraw the rejections and enter the amendments. If the Examiner has any questions or comments, or otherwise feels it would be advantageous, he is encouraged to telephone the undersigned at (713) 238-8043.

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